

ARGUMENTS

Rejection of Claims on Art Grounds in the 09/05/2003 Office Action, and Traversal Thereof

In the 05 September 2003 Office Action, Claims 1-38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/818,809.

The following claims were rejected under 35 U.S.C. 102(a):

Claims 1-2, 5-7, 9, 11-19, 21-31, 34 and 37-38 were rejected as being anticipated by Walker et al (U.S. 5,734,413).

Claims 1-4, 10-29, 32-34 and 37 were rejected as being anticipated by Miles et al. (U.S. 6,102,406)

The following claims were rejected under 35 U.S.C. 103 (a):

Claim 8 was rejected as being unpatentable over Walker.

Claims 35 and 36 were rejected as being unpatentable over Walker in view of You Don't Know Jack.

The above rejections of the claims 1-38 on the stated art grounds are traversed, and consideration of the patentability of the claims 1- 38 is requested, in light of the following remarks.

The applicant notes that the examiner has made both a 102 and 103 rejection by a reference he refers to as "Walker", first having specified the reference as "Walker et al (US Patent No. 5,713,413)". However, applicant notes that the combination of inventor(s), patent number, and description of that invention do not match with any references presently on the record. The examiner makes no citation or consideration of

US patent no. 5713413. The applicant will proceed under the assumption that the examiner is referring to the Walker reference cited by applicant in the IDS made of record, which is US Patent No. 5,779,549 to Walker et al., which discloses a database driven on-line distributed tournament system where remotely located players participate through devices connected to a central controller, wherein the system includes software and hardware to implement steps of a) identifying player, b) responding to payment of entry fee by player, c) accessing a database to store information generated by player, d) awarding prize for player for performance achievement. Further steps could include elimination or disqualification of players in tournament rounds.

As amended, the independent claims of the present invention provide for a method for hosting on-line gaming comprising the steps of: providing a computer-based game that a multiplicity of users can access via an Internet website displayed on a multiplicity of respective remote computers, wherein the multiplicity of users play simultaneously, and/or a method of doing business using on-line knowledge and skill-based gaming wherein a multiplicity of users play simultaneously and where revenue is generated based on the number of players who visit the website where the game is hosted and played, wherein the revenue is generated from sponsorship and/or advertising that is related to the number of players who visit the website where the game is hosted and/or played.

By contrast, the Miles reference provides for an on-line scavenger hunt game that requires generation of revenue by advertising wherein the scavenger hunt site operators ensure that participants actually visit the advertisers'/sponsors' sites by tracking the visits by players to those sites, and/or the "scheme" used to generate revenue by making the

players of the game go to a host site for enrollment and then go to locations on the Internet, once again by tracking the players' visits to the advertisers'/sponsors' websites, such as with "click through" rates for each "impression" (col. 4, lines 12-65). According to the Miles reference, the advertisers "pay for the guaranteed click throughs generated by the site" due to the method of playing the scavenger hunt game described therein. (col. 4, lines 60-64). Thus, the Miles reference actually teaches away from the present invention, wherein revenue is generated by players playing the game on a single site, not based on players visiting the sites of the advertisers, as taught by Miles.

Also, by contrast, the Walker reference requires players to pay an entry fee in order to generate revenue. This contrasts sharply with the advertising revenue model for the present invention, and teaches away from it, in fact, since if entry fees are collected for players, then there is no need for advertising to generate revenue from the site. As such, Walker teaches away from the present invention.

As for the "You Don't Know Jack" reference (hereinafter referred to as "Jack" for convenience), it is a "computer version of a board game" as stated in the first line of the first paragraph of that reference. Furthermore, it is clearly presented as a computer game for being played on a single computer, not by a network of remote computers, such as on the Internet, and can only be played by a limited number of players, maximum three players (see the second paragraph). Also, Jack includes a database with a finite number of questions that must be supplemented from time to time with new questions, downloaded to the single computer via a disc (see page 2 of the reference). Thus, the combination of Jack and Walker renders Jack non-functional, since it teaches a single computer-based game application, which prevents multiple users from remote locations

to play each other simultaneously (multiple computers running Jack would be playing independently without any awareness of other players not playing directly on their computer). By contrast, the present invention includes a database that contains a multitude of questions with answers, preferably greater than 20,000 questions with answers, that have been collected and have been independently confirmed to be accurate questions and answers, and which are updateable in real-time to the multiplicity of remote users simultaneously as it is preferably maintained as an ASP model with Internet access by the players. As such, the Jack reference teaches away from the combination with the Walker reference, since Jack is a self-contained computer game intended to be played from a database running on a single computer. Sound bytes and visual clips of Jack to be presented over the Internet would not necessarily reach remote players simultaneously, since bandwidth is not uniform and players may receive the information at different times, thereby not being capable of playing each other simultaneously in real-time as with the single-computer-based invention of Jack, where the players force an opponent to answer, which would need to happen in real-time, which is not possible over a distributed network where the players are in remote locations. By contrast, with the present invention, players can play the game at the same time over a remote network with their scores/results being compared to other users who play the game at the same time, wherein the questions may be provided to the players even with variations of time-based data transfer connections, since the user's success in music-based trivia gaming is based on correct answers (as in claim 6), not timed responses as with Jack. As such the present invention as in claims 35 and 36 is patentably distinct over the combination of Walker and Jack references as cited by the Examiner.

Furthermore, since the Jack reference is a desktop application for installation and use on a single computer, Jack teaches away from combination with the Walker reference or any reference that teaches a network-based system for generating revenue based upon advertising related to the multiplicity of users playing a game on a site, inasmuch as Jack is a self-contained database, software, and interface for play by two to three users; any revenue model based upon advertising to players where the revenue is limited to two or three advertising recipients is not going to generate revenue upon which a business model may be predicated.

Claims 1-38 are asserted to be in patentable condition. Allowance of these claims is hereby respectfully requested. In the event that the Examiner finds additional minor modifications that would place these claims in allowable condition, the Examiner is respectfully requested to make telephonic contact with the Attorney of Record to discuss and make changes via Examiner's Amendment to place the claims in condition for allowance.

The above rejections of the claims 1-38 on the stated art and utility grounds are traversed, and consideration of the patentability of the claims 1-38 is requested, in light of the foregoing remarks. Favorable action is therefore requested.

CONCLUSION

In view of the foregoing, claims 1-38, now amended, constituting the claims pending in the application, are submitted to be fully patentably and in allowable condition to address and overcome the rejections.

If any issues remain outstanding, incident to the allowance of the application, Examiner Capron is respectfully requested to contact the undersigned attorney at (919)-

664-8222 or via email at jinang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant, consistent with the applicant's making of a substantial advance in the art and particularly pointing out and distinctly claiming the subject matter that the applicant regards as the invention.

This Office Action response is submitted via fax to the official group fax number at 703.872.9306 on March 5, 2004.

Respectfully submitted,

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